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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/727,149

12/02/2003

David K. Swanson

03-0078 (US01)

5299

23410 7590 11/10/2008
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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

11/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/727,149	Applicant(s) SWANSON, DAVID K.	
	Examiner Michael Peffley	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/23/07; 7/16/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's amendment and response, filed August 18, 2008, have been fully considered by the examiner. The following is a complete response to the August 18, 2008 communication.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 51-84 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the pending claims of copending Application No. 10/727,096. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '096 application claims recite a more specific suction and sensing apparatus that would necessarily infringe on the instant application claims if they were to issue.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 51-84 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the pending claims of copending Application No. 10/784,316 in view of the teaching of Foley et al (6,663,622). The '316 applications recites the same basic suction apparatus, but fails to set forth the

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sensing electrodes located on the device. Foley et al disclose an analogous suction mechanism and specifically teach that it is known to provide sensing electrodes on opposite sides of the device to detect tissue characteristics during treatment.

This is a provisional obviousness-type double patenting rejection.

Claims 51-84 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the pending claims of copending Application No. 10/395,021 in view of the teaching of Foley et al (6,663,622). The '316 applications recites the same basic suction apparatus, but fails to set forth the sensing electrodes located on the device. Foley et al disclose an analogous suction mechanism and specifically teach that it is known to provide sensing electrodes on opposite sides of the device to detect tissue characteristics during treatment.

This is a provisional obviousness-type double patenting rejection.

Allowable Subject Matter

The double patenting rejections are the only rejections remaining in this application. Applicant's claims are deemed to distinguish over the prior art of record. In particular, the prior art fails to disclose the particular suction device having stimulation/sensing elements on opposite sides of the suction region and having the connector located between the energy elements as recited in the claims.

Foley et al disclose a similar device that includes a main body having a central area for holding an ablation element, a suction region on the main body and sensing

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electrodes (16) located on the body. However, Foley et al specifically teach that the sensing electrodes are located on an inner portion of the main body such that the suction region is located outside the sensing elements relative to the main body. There is no suggestion of providing the suction element between the sensing electrodes.

Applicant's argument with respect to the Bertolero et al device are deemed persuasive since Bertolero et al fail to disclose a suction region between the sensing elements. The Jahns et al ('382) and Francischelli et al ('360) devices similarly fail to disclose a suction region located between two electrode elements. Wellman et al (6,652,518) disclose electrode elements (43,45) located on opposite sides of a suction region. However, the Wellman et al electrodes are coagulation electrodes and there is therefore no connector located between the electrodes that is adapted to connect a coagulation element. Since Wellman et al already provides coagulation elements (and not sensing elements), there would be no motivation to provide the Wellman et al device with a connector adapted for connecting a separate coagulation element.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 7am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Peffley/
Primary Examiner, Art Unit 3739

/mp/
November 6, 2008